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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/824,224	04/13/2004	George S. Gabriel	364106/0349	6327

7590 08/10/2005
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EXAMINER

MICHENER, JOSHUA J

ART UNIT	PAPER NUMBER
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3644

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/824,224	Applicant(s) GABRIEL ET AL.	
	Examiner Joshua J. Michener	Art Unit 3644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-57 is/are pending in the application.
- 4a) Of the above claim(s) 1-22 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 45-57 is/are allowed.
- 6) ☒ Claim(s) 23, 24 and 27-44 is/are rejected.
- 7) ☒ Claim(s) 25 and 26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04/13/2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-22, drawn to a molding method, classified in class 264, subclass 645.
 - II. Claim 23-57, drawn to an animal valve assembly, classified in class 119, subclass 456.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process such as casting.
3. During a telephone conversation with Steven Pokotilow on August 1, 2005 a provisional election was made without traverse to prosecute Invention II, claims 23-56. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: 430 in Figure 30 [paragraph 0093]. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement

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drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

2. Claim 42 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. The phrase "wherein a part of said stem member is disposed" of Claim 42 is taken to read on the phrase "to be disposed in part within" of Claim 23.
3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claim 36 has been renumbered 37, thus claims 37-56 have been renumbered 38-57.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 23, 24, 27, 28, 34-38, 41, and 44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 2-7, 12 and 56-58 of copending Application No. 10/274619. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are extensive in scope.

6. Claims 23, 24, 27, 28, 41 and 44 recite relatively identical material as in Claims 2-7, 12, and 56-58. For example, claim 23 of the instant application recites a valve assembly comprising "an upper member having a piercing member and a connecting member." Claim 56 of the copending application recites a fluid delivery system comprising a valve assembly wherein the valve assembly comprises "a body having a piercing member and a connecting member, said body having... a flange member..." The body and flange member of the copending application is encompassed by the "upper member" of the instant application, which includes a flange as disclosed in the specification.

7. For Claims 34-37, the present application includes dimensions regarding a stem member, fluid channel, and spring. Application No. 10/27619 does not include such dimensions.

However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use any dimension, since it has been held to be within general skill of a worker in the art to select dimensions on the basis of suitability for the intended use as a matter of obvious design choice. Further, no specification was made to advantages of such dimensions and it is concluded that a variety of dimensions would work equally as well.

8. For Claim 38, the present application includes performance characteristics of a compressed spring. Application No. 10/27619 does not include such characteristics. However, the given performance characteristics are properties inherent to a spring and there are no specifications to any advantages for use of this spring over any other. Thus, it is concluded that another spring would work equally as well and it is of obvious design choice.

This is a provisional obviousness-type double patenting rejection.

9. Claims 29-33 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-7, 12, and 56-58 of copending Application No. 10/27619 in view of Edstrom Sr. et al. (US 5501177 A).

10. Application No. 10/27619 fails to recite actuation force requirements for the stem member of the valve assembly of 3 or 5 grams. Edstrom Sr. et al. discloses an animal watering valve with actuating forces between about 2 to about 6 grams (column 9, line 25). Thus, it would be obvious for one of ordinary skill in the art at the time the invention was made to modify Claims 29-33 of Application No. 10/27619 to include a range of force requirements as

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taught by Edstrom Sr. et al. because the valves are designed for young or weak animals which may not be able to apply sufficient actuating force.

This is a provisional obviousness-type double patenting rejection.

11. Claims 39 and 43 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-7, 12 and 56-58 of copending Application No. 10/27619 in view of Smith et al. (US 5,680,970).

12. Application No. 10/27619 fails to recite the use of polypropylene as a material for the upper member of the valve assembly. Smith et al. teaches of a valve constructed of polypropylene. Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the claim of Application No. 10/27619 to comprise of an upper member made from polypropylene because it is a resilient material and easy recyclable as taught by Smith et al.

This is a provisional obviousness-type double patenting rejection.

13. Claim 40 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-7, 12 and 56-58 of copending Application No. 10/27619 in view of Bajka (US 4,318,424).

14. Application No. 10/27619 fails to recite the use of silicone rubber as a sealing member. Bajka teaches of a silicone rubber seal for a water diverter valve. Thus, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the

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claim of Application No. 10/27619 to comprise of a silicone rubber seal because silicone rubber is known for its durability and workability.

This is a provisional obviousness-type double patenting rejection.

Allowable Subject Matter

15. Claims 25 and 26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. Claims 45-57 are allowed.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua J. Michener whose telephone number is (571) 272-1467.

The examiner can normally be reached on Monday through Friday 7-4.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on (571) 272-7045. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Joshua J Michener
Examiner
Art Unit 3644

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